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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,854	06/27/2006	Frank Bastiaan Brouwer	P16272-US1	1356
27045	7590	11/19/2008	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			CUMMING, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2617	
			MAIL DATE	DELIVERY MODE
			11/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,854

Applicant(s)

BROUWER, FRANK BASTIAAN

Examiner

WILLIAM D. CUMMING

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 1, 2008 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed method steps in claims 2-16; the Code Division Multiple Access (CDMA) system as stated in claims 1 and 25; the base station as stated in claim 25; and all the claimed means in the base station as stated in claims 25 and all the claimed means as stated in claims 35-40 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "*Replacement Sheet*" or "*New Sheet*" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings were received on October 1, 2008. These drawings are disapproved because of new matter. Applicant's attorney did not specifically point out support in the original specification for the draining.

Specification

4. The amendment filed November 11, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant's attorney did not specifically point out support in the original specification for the added three pages of the specification as stated below:

- i. FIG. 5 is a simplified block diagram of a CDMA system 500. Where this was originally supported in the specification?

- ii. The CDMA network includes a mobile station (MS) 502 communicating via one or more base stations (BS) 504 with a Radio Network Controller (RNC) 506. Where this was originally supported in the specification?
- iii. The RNC 506 has a code allocation unit 508 and operates in a UMTS Terrestrial Radio Access Network (UTRAN) 510. Where this was originally supported in the specification?
- iv. The RNC communicates with cord network service nodes, such as an MSC 512 and a General Packet Radio Service (GPRS) node 514. Where this was originally supported in the specification?
- v. For circuit-switched services, the MSC computes with the PSTN or ISDN 516. Where this was originally supported in the specification?
- vi. In addition, the GPRS node communicates with the Internet 518. Where this was originally supported in the specification?
- vii. To accomplish the methodology described above, the present invention may utilize the CDMA system 500 as illustrated in FIG. 5. Where this was originally supported in the specification?

viii. The base station 504 includes an intelligence module 520 capable of reducing radio signal interference caused by simultaneously deploying scrambling codes. Where this was originally supported in the specification?

ix. This reduction may be conducted by organizing channelization codes in a primary code tree and zero or more secondary code trees, where each of the code trees has zero or more alternative code trees. Where this was originally supported in the specification?

x. Each code tree may then have one or more channelisation codes per spreading factor. Where this was originally supported in the specification?

xi. The channelization codes are, according to their position in the code tree, denoted consecutively by a code index with a lowest to a highest value per spreading factor within each code tree. Where this was originally supported in the specification?

xii. The base station allocates a channelization code with the lowest code index out of a group of free channelization codes for a certain spreading factor to the channel according to a Compressed Mode type. Where this was originally supported in the specification?

xiii. The base station also allocates, through the intelligence module, a channelization code with the highest code index out of the group of free channelization codes for the certain spreading factor to a channel according to the second Compressed Mode type and transmits radio signals using these allocated channelisation codes. Where this was originally supported in the specification?

xiv. In addition, the base station, through the intelligence module may perform other functions, such as determining the type of CPM of the channel which is to be allocated a channelisation code, selecting a channelisation code from the group of free channelisation codes with a lowest code index where the selection starts from the left side of the primary code tree for allocating a channelisation code for a channel according to the first Compressed Mode type, selecting a channelisation code from the group of free channelisation codes with a highest code index, where the selection starts from the right side of the primary code tree for allocating a channelisation code for a channel according to the second Compressed Mode type. Where this was originally supported in the specification?

xv. In addition, the intelligence module may allocate a channelisation code to a channel according to a first CPM type by creating a list of candidate channelisation codes in the primary code tree which are free

and not reserved, excluding from the list a candidate channelisation code, having a corresponding parent code at the associated alternative code tree which is not free, selecting and allocating a candidate channelisation code from the list with a lowest code index, hence from the left side of the code tree, on the primary code tree, if more than one candidate channelisation code exists in the primary code tree, reallocating a channel according to the second Compressed Mode type from the primary code tree to an alternative code tree if there is no candidate channelisation code on the list, allocating the freed channelisation code to the channel according to the first CPM type, and allocating a channelisation code from a new secondary code tree if insufficient free space is created through reallocation of channels according to the second CPM type. Where this was originally supported in the specification?

xvi. Furthermore, the allocation of a channelisation code to a channel according to the second CPM type may include creating a list of candidate channelisation codes in the primary or secondary code tree which are free and not reserved, selecting and allocating a channelisation code from the list with a highest code index, hence from the right side of the code tree, on the primary or secondary code tree, if more than one candidate exists in the primary or secondary code tree, creating a first alternative list, if no candidate primary or secondary code tree exists, with candidate channelisation codes at a right side alternative code tree related to the

primary or secondary code tree, which channelisation codes must be free and not reserved and with the restriction that the same channelisation code at the related primary or secondary code tree must be used by a channel according to the second CPM type, selecting and allocating the candidate channelisation code with the highest code index from the first alternative list if more than one candidate channelisation code exists, creating a second alternative list with candidate channelisation codes at a left alternative code tree, which alternative code is related to said primary code tree, if no candidate channelisation code at the right alternative code tree exists, which channelisation codes must be free and not reserved and the same channelisation code at the primary code tree must be used by a channel according to the second CPM type, selecting and allocating the candidate channelisation code with the highest code index from said second alternative list if more than one candidate channelisation code exists, and allocating a channelisation code from a new secondary code tree if no candidate channelisation code at the left alternative code tree exists. Where this was originally supported in the specification?

xvii. The intelligence module may allocate a channelisation code to a channel according to the second CPM type utilizing the primary code tree or the secondary code tree and allocating a channelisation code to a channel according to the first CPM type utilize the primary code tree or the

secondary code tree. Where this was originally supported in the specification?

xviii. The first CPM type may be a Spreading Factor divide by 2 (SF/2) method, and the second CPM type may be a Higher level scheduling (HLS) or puncturing method. In addition, the CDMA system may be a WCDMA system. Where this was originally supported in the specification?

5. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2-16 and 25-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe the claimed the claimed method steps in claims 2-16; the Code Division Multiple Access (CDMA) system as stated in claims 1 and 25; the base station as stated in claim 25; and all the claimed means in the base station as stated in claims 25 and all the claimed means as stated in claims 35-40. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

8. Claims 2-16 and 25-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide an enabling disclosure the claimed method steps in claims 2-16; the Code Division Multiple Access (CDMA) system as stated in claims 1 and 25; the base station as stated in claim 25; and all the claimed means in the base station as stated in claims 25 and all the claimed means as stated in claims 35-40. The steps are not shown. The means are not shown, the base station is not shown and over all system is not shown. The means that do the steps are not shown. What the node is made of in order to have the claimed means is not disclosed. How the means are interconnected in the node is not shown. These steps and means are only known by the inventor and are not disclosed to the examiner or the public.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A 35 USC § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC § 101 and should be rejected as being directed to non-statutory subject matter. Thus, to qualify as a 35 USC § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)

Response to Arguments

11. Applicant's arguments filed October 1, 2008 have been fully considered but they are not persuasive.

Enablement requirement of 35 USC 112 is satisfied if the specification contains description that enables one skilled in the art to make and use the claimed invention (Fiers v. Sugano, 25 USPQ2d 1601). The examiner, in holding that disclosure is not enabling, can rely upon sound scientific reasoning as acceptable alternative to patents and printed publications. Lack of working examples is not controlling in determining whether disclosure meets enablement requirement of 35 USC § 112. A patent applicant who chooses to forego exemplification and bases utility on broad terminology and general allegations runs risk that, unless one with ordinary skill in art would accept allegations as obviously valid and correct, examiner may properly ask for evidence to substantiate them (Ex parte Sudilovsky, 21 USPQ2d 1702).

"New matter" prohibition of 35 USC §112 plays an important role in establishing the filing date of the application as prima facie date of the invention. Patent laws do not permit the insertion of additional descriptive matter subsequent to the filing date in order to complete the disclosure so as to conform the specification's description of the invention to statutory standard (Ex parte Maizel, 28 USPQ2d 1662). If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Conclusion

12. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM D. CUMMING whose telephone number is 571-272-7861. The examiner can normally be reached on Tuesday- Friday, 11:00am-8:00pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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